

REMARKS

This paper is submitted in response to the Office Action mailed May 17, 2007. Applicants acknowledge and appreciate Examiner's acceptance of the drawings submitted on April 9, 2004, as stated in the Office Action Summary. In regards to the claims, claims 1, 5, 7, and 10 have been amended. Claims 1-10 now remain in the application. In view of the foregoing amendments, as well as the following remarks, Applicants respectfully submit that this application is in complete condition for allowance and request reconsideration of the application in this regard.

The application was originally filed with 10 claims, of which claims 1-10 have been rejected.

Claims 1-10 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,885,299 to Winslow et al. ("Winslow").

In the Office Action, the Rejection asserts, in pertinent part:

The distal end of the inner lumen includes an axially directed shoulder that can abut against a proximal end of the spinal implant (col. 4, lines 34-39). The distal end of the inner lumen includes threads for threadably engaging a portion of the spinal implant (col. 4, lines 40-49). It is noted that the distal end of the inner lumen disclosed by Winslow has an implant engaging structure that is capable of performing the functions of the claimed invention. The spinal surgical instrument (100) further includes a driver portion (see Figure 1 below). The inner cannula including threads on an interior surface of the inner lumen; the distal end of the fixing member (132) includes exterior threads (44); and threading the exterior threads of the fixing member with the interior threads of the inner cannula provides for advancing and retracting the fixing member (132) within the inner lumen of the inner cannula (118; col. 4, lines 66-67 and col. 5, lines 1-2).

(Office Action, p. 3).

Applicants respectfully disagree with various assertions made in the Rejection. In particular, the assertion that Winslow teaches an inner lumen having threads is inaccurate. The Rejection moreover cites column 4, lines 40-49 as providing such teaching. Applicants' undersigned counsel has studied Winslow and failed to find any such structure. In fact, none of the figures nor the cited text in Winslow teach a threaded inner lumen (defined by inner cannula 118). Moreover, the figures and specification in Winslow fail to teach threads of the inner lumen for threadably engaging a portion of the spinal implant. Similarly, and contrary to the assertion made in the Rejection, Winslow fails to teach an inner cannula including threads on an interior surface of the inner lumen such that "threading the exterior threads of the fixing member with the interior threads of the inner cannula provides for advancing and retracting the fixing member (132) within the inner lumen of the inner cannula" (Office Action at p. 3).

Accordingly, independent claim 1 has been amended to more clearly define over Winslow. In particular, claim 1 has been amended to recite, in pertinent part, the inner lumen including threads configured to threadably engage a portion of the spinal implant.

Accordingly, since independent claim 1 recites a combination of elements not taught or suggested in Winslow, Applicants respectfully submit that independent claim 1 should be allowed.

Claim 5 has been similarly amended to depend from independent claim 1 and adds a limitation where the fixing member is threadably engaged with the threads of the inner cannula. This limitation is fully supported by the specification and drawings (See Application at Fig. 4 and par. 44).

Claims 2-8 depend from allowable independent claim 1. Moreover, as each of these claims recites a combination of elements not taught or suggested in Winslow, Applicants respectfully submit that claims 2-8 are allowable as well.

In regards to independent claim 9, and as noted above, Winslow fails to teach an inner cannula including threads on an interior surface of the inner lumen such that threading the exterior threads of the fixing member with the interior threads of the inner cannula provides for advancing and retracting the fixing member within the inner lumen of the inner cannula.

Accordingly, Applicants respectfully submit that independent claim 9 recites a combination of elements not taught or suggested in Winslow and should therefore be allowed.

Moreover, as claim 10 depends from allowable independent claim 9, and further as claim 10 recites a combination of elements not taught or suggested in Winslow, Applicants respectfully submit that claim 10 is allowable as well.

Claims 5 and 7-9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Winslow in view of U.S. Patent No. 5,649,931 to Bryant et al. ("Bryant"). The Rejection fails to show a *prima facie* case of obviousness. With particular regard to claims 5 and 7-8, which directly or indirectly depend from allowable independent claim 1, the Rejection fails to show a teaching in Winslow or Bryant where the inner lumen includes threads configured to threadably engage a portion of the spinal implant. With particular regard to independent claim 9, the Rejection fails to cure the deficiency pointed out above in regard to threading the exterior threads of the fixing member with the interior threads of the inner cannula providing for advancing and retracting the fixing member within the inner lumen of the inner cannula.

Accordingly, since the Rejection fails to establish a *prima facie* case of obviousness of claims 5 and 7-9, and further as each of these claims recites a combination of elements not taught or suggested in Winslow, alone or in combination with Bryant, Applicants respectfully submit that claims 5 and 7-9 are allowable.

Conclusion

In view of the foregoing response including the amendments and remarks, this application is submitted to be in complete condition for allowance and early notice to this effect is earnestly solicited. If the Examiner believes any matter requires further discussion, the Examiner is respectfully invited to telephone the undersigned attorney so that the matter may be promptly resolved.

Applicant believes that no fees are due in connection with this response, and hereby petitions for same. However, if any additional petition is required or any fees are necessary, the Commissioner may consider this to be a request for such and charge any necessary fees to deposit account 23-3000.

Reconsideration and Notice of Allowance is respectfully requested.

Respectfully submitted,

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